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30409 7590 11/23/2009 INTERNATIONAL ENGINE INTELLECTUAL PROPERTY COMPANY 4201 WINFIELD ROAD P.O. BOX 1488 WARRENVILLE, IL 60555				
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* GREGORY A. GRIFFIN and CRAIG R. KNAUF

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Appeal 2008-005901  
Application 10/777,745  
Technology Center 3600

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Decided: November 19, 2009

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Before JOHN C. KERINS, MICHAEL W. O'NEILL, and  
FRED A. SILVERBERG, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Gregory A. Griffin et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-4 and 6-20. Appellants canceled claim 5. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

### *The Invention*

The claimed invention is to a metal and elastomeric gasket for sealing oil pick-up tubes attached to the front cover of an engine. Spec. 1, paras. [0001-0002].

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A gasket comprising:

a metal substrate disposed along an outer perimeter of the gasket;

an elastomeric bead disposed along at least a part of an interior perimeter of the metal substrate;

an elastomeric ring disposed around an opening of the metal substrate, wherein the elastomeric ring has an inner diameter, wherein the opening has an opening diameter, and wherein the inner diameter of the elastomeric ring is smaller than the opening diameter of the opening;

wherein a fastener that is disposable within the opening has an outer diameter, and wherein the inner diameter is smaller than the outer diameter of the fastener, such that the fastener is retained with the gasket when the fastener is inserted in the elastomeric ring by radially compressing the elastomeric ring between the fastener and the opening.

### *The Prior Art*

The Examiner relies upon the following as evidence of unpatentability:

Nenzell	US 2,795,444	Jun. 11, 1957
Farnam	US 3,811,689	May 21, 1974
Harris	US 4,091,141	May 23, 1978
Fucci	US 4,819,954	Apr. 11, 1989
Belter	US 5,618,047	Apr. 8, 1997
Inciong	US 6,543,787 B1	Apr. 8, 2003
Schenk	US 6,553,664 B1	Apr. 29, 2003

*The Rejections*

The following Examiner's rejections are before us for review:

*Non-art Rejection*

Claims 1-4 and 6-7 stand rejected under 35 U.S.C. §112, second paragraph.

For this rejection, the Examiner finds it unclear how a gasket can have a fastener. Ans. 3.

*Art Rejections*

Claims 1-3 and 6-12 stand rejected under 35 U.S.C. §103(a) given Schenk in view of Farnam and further in view of Fucci.

Claims 1-3 and 6-12 stand rejected under 35 U.S.C. §103(a) given Belter in view of Farnam and in further view of Fucci.

Claim 4 stands rejected under 35 U.S.C. §103(a) given Schenk in view of Farnam and Fucci, and further in view of Inciong.

Claims 13-20 stand rejected under 35 U.S.C. §103(a) given Belter in view of Farnam and Fucci, and further in view of Nenzell.

Claims 13-20 stand rejected under 35 U.S.C. §103(a) given Schenk in view of Farnam and Fucci, and further in view of Nenzell.

For these rejections, the Examiner relies on Farnam to satisfy the claim limitation that limits the ring to an elastomeric ring. Ans., *passim*. Responding to Appellants' arguments, the Examiner finds that Harris supports the Examiner's finding that Farnam's ring is made from an elastomer because the Examiner's posits that the disclosure of Harris permits a finding that phenolic filled asbestos is an elastomeric material. Ans. 9.

### *Contentions*

Appellants contend that a gasket as called for in claim 1 is what they regard as their invention, and that a person having ordinary skill in the art would understand the scope and content of claim 1, as currently presented, to include a fastener. App. Br. 9. Appellants contend that the Examiner has made a factual error in finding that Farnam's disclosure, supported by Harris, teaches or suggests that the bushing 24 is elastomeric. *See* Reply Br. 2-3.

### SUMMARY OF DECISION

We REVERSE.

### OPINION

#### *Issues*

The issues before us in this appeal are as follows:

Have Appellants shown the Examiner erred in concluding claim 1 is indefinite?

Have Appellants shown the Examiner erred in finding that the content of Farnam, supported by Harris, describes a bushing made from an elastomer?

#### *Pertinent Facts*

1. Farnam describes that an insert member or bushing 24 is provided with an aperture 25 sized to receive a retaining bolt at final assemblage of flanged components. Col. 2, ll. 31-34.
2. Farnam describes that the insert member 24 "must be of a high strength low thermal conductivity so as to retain the proper size for the

- bolt hole, as well to support the flange clamping loads of the heat insulating structure.” Col. 2, ll. 48-52.
3. Farnam describes that “[t]he insert member generally will be of a solid molded construction, however, there may be instances where a laminated asbestos fiberboard or paper structure may be used....” Col. 2, ll. 52-55.
  4. Farnam describes that suitable materials for the manufacture of the insert member 24 are “phenolic filled asbestos millboard laminates, phenolic filled asbestos paper board laminates, solid molded plastics and metallic insert members.” Col. 3, l. 60 to col. 4, l. 2.
  5. Farnam describes the essential criterion in selecting the material to manufacture the insert member 24 “is whether [the material] has a high compression strength to resist the pressing force under the flange loads in the field of use.” Col. 4, ll. 2-5.
  6. Harris describes impregnating or coating fiber webs formed of minerals such as asbestos, glass, and mineral wool with the photocurable elastomeric polyester composition disclosed within. The resultant compound yields “highly desirable elastomeric webs of superior physical characteristics.” Col. 6, ll. 1-6.

*Principles of Law*

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the Examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967).

*Analysis*

*Issue (1) § 112, second paragraph, rejection*

Turning first to the rejection of claims 1-4 and 6-7 under 35 U.S.C. § 112, second paragraph, we reverse this rejection. According to the Examiner, because it is unclear how a gasket can have a fastener, the claims are indefinite. However, besides the conclusory statement that this is unclear to the Examiner, the Examiner never provides a reason why one of ordinary skill would not understand the metes and bounds of the claimed subject matter. As noted by the court in *In re Swinehart*, 439 F.2d 210, 213 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought. The issue is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of the terms should be permitted even though the claim language is not as precise as the Examiner might desire, as the case appears to be here. In our view, when reading the claims in light of the Specification, the claims are directed to a gasket that includes a fastener, and a person having ordinary skill in the art would readily comprehend the scope and content of the claims as including the fastener. Therefore, it is our conclusion of law that the

subject matter of claims 1-4 and 6-7 is not indefinite under the second paragraph of 35 U.S.C. § 112.

*Issue (2) § 103(a) rejections*

Turning to the rejections of claims 1-4 and 6-20 as obvious, we reverse these rejections because the Appellants' contentions that the Examiner made factual errors have merit. While we agree with the Examiner that Farnam describes a ring, *see* Fact 1, we disagree with the Examiner that the claimed elastomeric ring is fully met by Farnam's ring, notwithstanding the Examiner's reliance on Harris as allegedly supporting that finding.

Farnam's ring (insert or bushing 24 in Farnam's nomenclature) is designed to maintain a high strength and low thermal conductivity in order to retain its proper bolt hole size. Fact 2. Farnam describes that the ring is constructed from a solid molded construction or a laminated asbestos fiberboard or paper structure. Facts 3 and 4 and *see also* Figures 2, 4, and 6 (showing the insert member 24 in section and the symbol for synthetic resin or plastic). Farnam describes that the essential criterion for the ring material is that it have high compression strength. Fact 5. Accordingly, the Farnam disclosure of its ring material and the criteria for selecting the material do not clearly disclose or suggest the use of an elastomeric material, and indeed appear to teach away from an elastomeric material.

The Examiner's reliance on Harris to evidence that the phenolic filled asbestos disclosed in Farnam is an elastomeric material, *see* Ans. 9, is a factual error as Appellants contend. Harris describes an elastomeric polyester composition that includes a phenolic crosslinking agent applied to fiber webs to form a fiber web with some elastomeric properties, *see* Fact 6.



The Examiner appears to equate the impregnated fiber webs of Harris, or the properties thereof, to the phenolic filled asbestos millboard laminates and phenolic filled asbestos paper board laminates disclosed in Farnam. The Examiner, however, provides no evidence that the phenolic composition used in the Harris polymer as a crosslinking agent is what imparts the elastomeric properties to the impregnated fiber web. The Examiner has also not established that the Harris phenolic composition is the same as, or is similar to, the phenolic composition(s) employed in the Farnam. As such, the Examiner has not provided evidence that the phenolic filler used in the asbestos millboard and paperboard laminates renders those products elastomeric. Furthermore, to the extent that the base materials play any role in whether the finished products exhibit elastomeric properties, the Examiner has not shown that the fiber web in Harris and the millboard and paperboard laminate structures in Farnam are the same or similar in construction and properties.

The Examiner does not use Schenk, Belter, Fucci, Inciong, or Nenzell to cure the deficiency of Farnam disclosing an elastomeric ring.

### CONCLUSIONS

Appellants have shown the Examiner erred in concluding that claim 1 is indefinite.

Appellants have shown the Examiner erred in finding the content of Farnam, as evidenced by Harris, describes a bushing made from an elastomer.

DECISION

The Examiner's decision to reject claims 1-4 and 6-7 as indefinite under 35 U.S.C. § 112, second paragraph, is reversed.

The Examiner's decision to reject claims 1-4 and 6-20 under 35 U.S.C. § 103(a) is reversed.

REVERSED

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